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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,521	09/10/1999	NAOYUKI MATSUMOTO	35.G0708C/D2	4346

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,521

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This communication is responsive to amendment received on January 28, 2002.

Applicant amends claims 25 and 29.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita et al (US Patent No. 5,021,892) in view of Shimotono (US Patent No. 4,964,154).

Concerning claims 25, 26, Kita discloses a data communication apparatus in a data processing system (Fig.3) that includes the data communication apparatus (1) and a host computer (8) connected to the data communication apparatus by an interface (PRL I/F), comprising a communication step of communicating with a communication partner through a network (4a); a notification step of notifying the host computer of information regarding the communication partner; a setting step of setting one of an on-line mode, to be operated based on a command from the host computer, and an off-line mode, to be operated even without a command from the host computer; the notification step notifies the host computer in a case where the on-line mode is set in the setting step (col. 2, lines 22-59; col. 3, lines 28-68; col. 6,

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lines 20 – col. 8, line 48; col. 9, line 26 – col. 10, line 14; col. 15, line 42 – col. 16, line 68; col. 21, line 60 – col. 22, line 13).

Kita does not directly mention the communication step of communicating protocol information and document information with a communication partner. However, it was commonly known in the art that in order to have a communication between 2 communication devices, the 2 communication devices have to exchange communication protocol information and document information. Shimotono supports that well known in the art by teaching a communication device for use in facsimile device combined with computer which connects a facsimile devices with each other wherein the communication device 2 communicate with a remote facsimile side 5 and notifies the host computer 3 regarding the communication partner 5 based on protocol information received in the communication step through interface (Figs.4-6, 8; col. 6, line 64 – col. 9, line 63; col. 12, line 36 – col. 13, line 30; col. 14, lines 24-45). . It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the communication between a communication device 2, a remote facsimile device 5 and a computer 3 in Shimotono to the communication step in Kita since Kita also teaches the communication between a communication device 1, a remote facsimile device and a computer 8.

Concerning claims 27-28, 31, Kita further teaches that the notification step notifies the host computer in accordance with a command from the host computer; and the data communication apparatus is included in a facsimile apparatus (4).

Concerning claims 29-30, Kita discloses a method of controlling a data processing apparatus in a data processing system having the data processing apparatus and a host computer comprising an instruction reception step and notification step as discussed in claim 25 above.

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Kita fails to teach that the notification step notifies the host computer of information about a model type and a model version of the data processing apparatus. Shimotono teaches the communication between a remote facsimile device 5, a communication device 2 and computer 3 (Figs.4-6, 8) wherein the communication device 2 notifies the computer 3 of information about the device of the communication device 2 (col. 6, line 64 – col. 9, line 63; col. 12, line 36 – col. 13, line 30; col. 14, lines 24-45). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the communication between a communication device 2, a remote facsimile device 5 and a computer 3 in Shimotono to the communication step in Kita since Kita also teaches the communication between a communication device 1, a remote facsimile device and a computer 8.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Koshiishi (US Patent No. 4,652,933) discloses an image formation processing system with a combination of a facsimile apparatus and a personal computer.

b. Ina (US Patent No. 4,786,974) teaches an image formation processing system for image formation inside the system or information transfer to or from an external system.

c. Lin (US Patent No. 4,991,200) recites interface device for the intercommunication of a computer and a fax machine.

4. Applicant's arguments with respect to claims 25-31 have been considered but are moot in view of the new ground(s) of rejection.

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

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Anh Wanh Nguyen

Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
April 19, 2002